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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,463	03/27/2001	William Skiles	SKILES 00.01	1833

7590

04/14/2003

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,463

Applicant(s)

SKILES, WILLIAM

Examiner

Ruth C. Rodriguez

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 20-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 31 is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 20-22 and 27-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Willner (US 3,693,376).

A jewelry clasp (10) for releaseably holding an ornamental object (16) comprises a first fixture (14), a second fixture (14) and a spring member (12). The first fixture comprises a first convexoconcave structure having a first inner concave surface (22), a first outer convex surface and a first edge (20) continuously joining the first inner concave surface to the first outer convex surface (Figs. 1-4). The second fixture comprises a second convexoconcave structure having a second inner concave surface (22), a second outer convex surface and a second edge (20) continuously joining the second inner concave surface to the second outer convex surface (Figs. 1-4). The

spring member has semicircular shape (Figs. 1-3) and a first end (18) and a second end (18) where the first end is affixed to the first outer convex surface of the first fixture, interiorly of the first edge, and the second end is affixed to the second outer convex surface of the second fixture, interiorly of the second edge (Figs. 1-3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willner in view of Darling (US 3,693,376).

Willner discloses a clasp having all the limitations listed above for the rejection of claim 5 above. However, Darling teaches the use of buoyant putty (cellular material) for jewelry (C. 1, L. 26-39). The putty will prevent the piece of jewelry from sinking when immerse in water (C. 2, L. 5-13). Darling also teaches that the buoyant putty also protects objects being hold with the putty against damage (C. 10, L. 33-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a first cellular material disposed on the first inner surface of the first fixture and a second cellular material disposed on the second inner surface of the second fixture according to the teachings of Darling in the device of Willner. Doing

so, will prevent the object being held from becoming damaged and will also provide buoyancy to the piece of jewelry if it were to become immerse in water.

Allowable Subject Matter

6. Claims 30 and 31 allowed.
7. Claims 20-22 and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 21 February 2003 have been fully considered but they are not persuasive.
9. The first argument present by the Applicant is that Willner fails to disclose that spring members are mounted interiorly of the edges of the fixtures on the outer convex surfaces of the fixtures. This argument fails to persuade by this argument. The Examiner disagrees with this argument because Willner does disclose this limitation as can be seen in figure 3 where one having ordinary skill in the art at the time of applicant's invention will recognize that the first or second end of the spring is affixed to the respective first or second outer convex surfaces and extends interiorly of the respective first or second edge.

10. The Applicant also argues that the ornamental member will be mounted on the circle defined by the semi-circular shape of the Applicant's spring member. This argument is not considered relevant to the claims because the Applicant fails to include this limitation in the claims. However, Willner will still anticipate this limitation if it was added to the claim because Willner discloses that most of the area of the inner concave surface is located exteriorly of a circle defined by the spring member, therefore a portion of this area of the inner concave surface will be located within a circle defined by the spring member.

11. For commercial success of a product embodying a claimed invention to have true relevance to the issue of nonobviousness, that success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter. Thus a nexus is required between the merits of the claimed invention and the evidence offered, if that evidence is to be given substantial weight in route to a conclusion on the obviousness issue. *Cable Electric Product, Inc. v. Genmark, Inc.*, 770 F. 2d 1015, 226 USPQ 881.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wecht (US 1,251,308), Kirshner (US 3,014,298), Johnson (US 4,195,492), Milawski (US 4,625,526), Santiago (US 5,433,090), Guio (US 5,440,791), Hanson (US 5,946,943) and German Patent Document DE 31 04 396 A1 are cited to show state of the art with respect to the use of clasps or clips having some of the features claimed under the current application. Miller (US 3,896,527) and Willoughby (US 4,536,924) are cited to show state of the art with respect to the use of a ratchet system to urge two sides of a clamp together.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

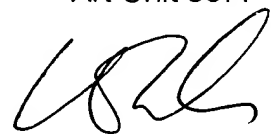
Submissions of your responses by facsimile transmission are encouraged.

Technology center 3600's facsimile number for before final communications is (703) 872-9326. Technology center 3600's facsimile number for after final communications is (703) 872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

RCR
rcr
April 9, 2003


WILLIAM MILLER
PRIMARY